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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,907	08/30/2000	John Underwood	730301-2013	2355
20999 7590 04/17/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2178	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/17/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 09/651,907	Applicant(s) UNDERWOOD ET AL.	
	Examiner Joshua D. Campbell	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-26 and 28-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-26 and 28-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is responsive to communications: Request for continued examination filed on 2/20/2007.
2. Claims 1, 3-26, and 28-54 are pending in this case. Claims 1, 26, and 51-54 are independent claims. Claims 1, 26, and 51-54 have been amended.

### ***Double Patenting***

3. Applicant is advised that should claim 26 be found allowable, claim 54 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
4. Applicant is advised that should claim 51 be found allowable, claim 53 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 52 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory for at least the reason that they are not tangibly embodied in a manner so as to be executable (i.e. stored on a computer readable storage medium, specifically not including a carrier wave or other transmission medium). Further, a collection of fields such as a set of program instructions is non-functional descriptive material unless it is being executed, thus it may also be considered to be merely an abstract idea, which is again non-statutory. Proper correction of the claims is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 3-26, and 28-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not at any point teach or discuss the generation of external interfaces and/or external interface generators, which is contained in the new

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amendments to every independent claim. Instead, the specification merely discusses invoking interfaces that already exist as part of an API (page 66, line 19-page 67, line 4 of applicant's specification). It is noted that the definition of the words invoke and generate as they are well-known in the art do not correlate, and thus there is no support in the applicant's specification for the "generation" of external interfaces. In order to further prosecution, the examiner has pointed out in the current rejection where external interfaces are used. However, regardless of this fact proper correction to the claims is still required.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 3-5, 7, 9-16, 18, 20, 22-26, 28-30, 32, 34-41, 43, 45, 47-50, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxter et al. (US Patent Number 6,356,903, filed on December 30, 1998) in view of Barr et al. (hereinafter Barr, US Patent Number 5,742,816, issued on April 21, 1998).

**Regarding independent claim 1,** Baxter et al. (hereafter referred to as Baxter) discloses a method in which content (dimensions) including formatting components and organizational components are stored in a repository (column 2, lines 1-11 of Baxter). Baxter discloses a method in which format components, templates which define formats (characteristics), are stored in a repository. The formats define what content is used (subset) and how it is to be formatted (column 4, lines 25-53 of Baxter). Baxter also

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discloses a method in which a web document is based on a template (column 14, lines 5-28 of Baxter) and it is assembled by a system (description generator) to create a complete set (description) of content, organizational components and form components (column 16, lines 28-37 of Baxter). Baxter discloses that editors may edit any of the content at any time, thus editing the description (column 1, lines 39-42 of Baxter). Baxter discloses external interfaces are provided to handle external components such as externally hosted applications that generate custom content for inclusion in the web site (column 5, line 58-column 6, line 11 of Baxter). Baxter et al. does not disclose that data is stored according to an industry type classification. However, Barr shows that it is notoriously well-known to store data according to classifications (column 1, lines 66-column 2, lines 20 of Barr). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Baxter et al. and Barr because categorized data is easier for a user to search.

**Regarding dependent claim 3,** Baxter discloses a method in which a template can be used to create more than one finalized web page (description), thus the probability is less than one that it will create the same description using the same template (column 15, line 66-column 16, line 9 of Baxter).

**Regarding dependent claim 4,** Baxter discloses a method in which templates are used to create new documents that are different from other documents created based on the template (column 16, lines 1-22 of Baxter).

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**Regarding dependent claim 5**, Baxter discloses a method in which a complete set (description) created based on a template is stored in a repository (column 16, lines 38-50 of Baxter).

**Regarding dependent claim 7**, Baxter discloses a method in which templates are used to create new documents that are different from other documents created based on the template (column 16, lines 1-22 of Baxter). Thus, the method is non-deterministic because it allows for more than one possible result.

**Regarding dependent claims 9-16**, Baxter discloses a method in which content includes raw content (text, graphics, images), organization (layout and navigation), java applications (component applications), colors, and outline (theme) (column 4, lines 25-67, column 14, lines 5-28, and column 16, lines 1-9 of Baxter).

**Regarding dependent claim 18**, Baxter discloses a method in which the finalized document corresponds to a set of content, organization and format (more than two dimensions combined together) (column 16, lines 28-37 of Baxter).

**Regarding dependent claim 20**, Baxter discloses a method in which the definitions set forth by the template use only a portion (subset) of the content (select pictures, certain colors, etc.) available (column 2, lines 1-24 of Baxter).

**Regarding dependent claim 22**, Baxter discloses a method in which the definitions set forth by the template use only a portion (subset) of the content (select pictures, certain colors, etc.) available (column 2, lines 1-24 of Baxter).

**Regarding dependent claim 23**, Baxter discloses a method in which the finalized document corresponds to a set of content, organization and format (more than

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two dimensions combined together) as defined by the template (column 16, lines 28-37 of Baxter).

**Regarding dependent claims 24-25**, Baxter discloses a method in which a corporate logo may be applied to a set of templates to designate them for use on a corporate site (specific industry) or templates can be created without a specific logo between them (general industry) (column 12, lines 7-43 of Baxter).

**Regarding claims 26, 28-30, 32, 34-41, 43, 45, and 47-50**, the claims incorporate substantially similar subject matter as claims 1, 3-5, 7, 9-16, 18, 20, and 22-25. Thus, the claims are rejected along the same rationale as claims 1, 3-5, 7, 9-16, 18, 20, 22-25.

**Regarding independent claims 51-54**, the claims incorporate substantially similar subject matter as claim 1. Thus, the claims are rejected along the same rationale as claim 1.

10. Claims 6, 8, 31, and 33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Baxter et al. (US Patent Number 6,356,903, filed on December 30, 1998) in view of Barr et al. (hereinafter Barr, US Patent Number 5,742,816, issued on April 21, 1998) as applied to claim 1 above, and further in view of Ryan et al. (US Patent Number 6,421,675, filed on July 15, 1998).

**Regarding dependent claim 6-8**, Baxter does not disclose a method in which a description is generated randomly or pseudo-randomly. However, Ryan et al. discloses a method in which a results page for a search engine randomly selects applicable



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results (content) to put into a template for a results page that is generated (column 22, Ryan et al.). Since the random selection is completed by a computation it is by definition also pseudo-random. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of Baxter in combination with the method of Ryan et al. because it gives the opportunity for the less popular content to viewed on the generated web pages.

**Regarding dependent claims 31 and 33**, the claims incorporate substantially similar subject matter as claims 6 and 8. Thus, the claims are rejected along the same rationale as claims 6 and 8.

11. Claims 17, 19, 21, 42, 44, and 46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Baxter et al. (US Patent Number 6,356,903, filed on December 30, 1998) in view of Barr et al. (hereinafter Barr, US Patent Number 5,742,816, issued on April 21, 1998) as applied to claims 1, 18, 26, and 43 above, and further in view of Hill et al. (US Patent Number 6,023,714, filed on April 24, 1997).

**Regarding dependent claim 17**, Baxter does not disclose a method in which one of the dimensions is the platform used to access the site. However, Hill et al. (hereafter referred to as Hill) discloses a method in which a web document is generated using a stylesheet (template) in which it is properly formatted and organized based on the system the user is using to view the document (column 2, lines 15-65 of Hill). It would have been obvious to one of ordinary skill in the art at the time the invention was

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made to have combined the methods of Baxter and Hill because it would have allowed more users to properly view the generated document.

**Regarding dependent claim 19**, Baxter does not disclose the use of a predetermined relationship between at least two characteristics. However, Hill discloses a method in which all the characteristics of the dimensions are share a predetermined relationship with the platform used to access a document in stylesheets in order to properly format the document for all platforms, which dictates other characteristics selected (i.e. format, content, color, etc.) (column 1, lines 15-65 of Hill). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Baxter and Hill because it would have allowed more users to properly view the generated document.

**Regarding dependent claim 21**, Baxter does not disclose the use of a predetermined relationship between at least two characteristics. However, Hill discloses a method in which all the characteristics of the dimensions are share a predetermined relationship with the platform used to access a document in stylesheets in order to properly format the document for all platforms (column 1, lines 15-65 of Hill). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Baxter and Hill because it would have allowed more users to properly view the generated document.

**Regarding dependent claims 42, 44, and 46**, the claims incorporate substantially similar subject matter as claims 17, 19, and 21. Thus, the claims are rejected along the same rationale as claims 17, 19, and 21.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 3-5, 7, 9-16, 18, 20, 22-26, 28-30, 32, 34-41, 43, 45, 47-50, and 51-54 have been considered but are moot in view of the new ground(s) of rejection. The lack of enablement rejection provides enough basis to render the arguments moot, however in addition to this the rejection has been clarified to include proper basis to rejection even the non-enabled limitation.

13. Applicant's arguments filed 2/20/2007 have been fully considered but they are not persuasive.

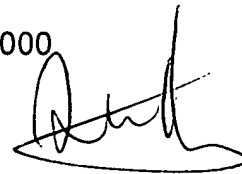
Regarding the arguments on pages 14-15 regarding the motivation to combine the teachings of the Baxter and Barr, the examine maintains that the motivation is proper and thus the rejection is proper. Baxter et al. does not disclose that data is stored according to an industry type classification. However, Barr shows that it is notoriously well-known to store data according to classifications (column 1, lines 66-column 2, lines 20 of Barr). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Baxter et al. and Barr because categorized data is easier for a user to search. The applicant has provided no arguments as to whether or not the motivation to combine is proper, rather has merely cited portions of the MPEP without actually applying any of the statements to the rejection as it is presented. Thus, the arguments presented result in nothing more than a mere allegation of patentability with no proper arguments included.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JDC  
April 9, 2007

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**